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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|---|-------------|----------------------|----------------------------|------------------------|
| 10/559,396  | 04/03/2006  | Kai-Jens Matejat     | 05-949                     | 5607                   |
| 20306 7590 10/18/2007<br>MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP<br>300 S. WACKER DRIVE<br>32ND FLOOR<br>CHICAGO, IL 60606 |             |                      | EXAMINER<br>PHASGE, ARUN S |                        |
|   |             |                      | ART UNIT<br>1795           | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>10/18/2007    | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/559,396 | <b>Applicant(s)</b><br>MATEJAT ET AL. |  |
|                              | <b>Examiner</b><br>Arun S. Phasge    | <b>Art Unit</b><br>1795               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 103*

Claims 1, 4-5, 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fronsman in view of Japanese patent 51-119632 A of record for reasons of record.

Claims 2-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fronsman in view of the Japanese patent as applied to claims above, and further in view of Harms of record for reasons of record.

#### *Response to Arguments*

Applicant's arguments filed 8/6/07 have been fully considered but they are not persuasive.

Applicants argue that the Fronsman apparatus would allow the electrolyte to contact both electrodes at the same time, whereas the present claims require the contact first with the cathode with subsequent flow to the anode. The present apparatus does not include a membrane to separate the electrodes. Accordingly,

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the electrolyte would contact both the electrodes, since the current would only pass through the electrolyte between the electrodes.

Applicants further argue that the prior patents disclose an unsealed cell. The scope of a "sealed cell" is broad, since the cell is not totally closed off, because the electrolyte flows through in and out of the cell. Therefore, the cell disclosed in Fronsman would meet the "sealed cell" because the Fronsman patent uses a cover (see figure 2 and col. 5, lines 14-17).

Applicants further state that the level of skill of the ordinary artisan is such that a prior art disclosing a plurality of electrode pairs would not render obvious a single pair of electrodes.

This is not found to be persuasive. To reduce or increase the electrode pairs based upon the amount of material being treated would have clearly been within the scope of the ordinary artisan.

Applicants appear to be arguing that the Harms patent is drawn to a non-analogous art and as such is not combinable with the Fronsman patent.

Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor, but it does not require us to presume full knowledge by the inventor of prior art outside the field of his endeavor, i.e. of "non-analogous"

art. In that respect, it only requires us to presume that the inventor would have that ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be expected of a man of ordinary skill in the art to which the subject matter pertains. *In re Antle*, 170 U.S.P.Q. 285.

The Harms patent is directed to arts that are reasonably pertinent to the particular problem of measuring to determine the concentration by potentiationmetric measurements.

Therefore, the claims stand rejected.

#### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

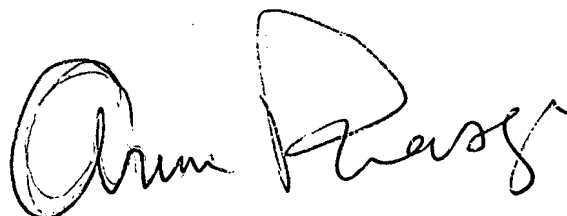
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is (571) 272-1345. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X. Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Arun Phasge', with a large, stylized initial 'A'.

Arun S. Phasge  
Primary Examiner  
Art Unit 1795

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